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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/648,908	08/27/2003	Scott J. Brabec	P-9676.00	4394
27581	7590	01/27/2006	EXAMINER	
MEDTRONIC, INC. 710 MEDTRONIC PARK MINNEAPOLIS, MN 55432-9924			ALTER, ALYSSA M	
			ART UNIT	PAPER NUMBER
			3762	

DATE MAILED: 01/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/648,908

Applicant(s)

BRABEC ET AL.

Examiner

Alyssa M. Alter

Art Unit

3762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 November 2005.  
 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5 and 7-35 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
 6) ☐ Claim(s) 1-5 and 7-35 is/are rejected.  
 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
 10) ☒ The drawing(s) filed on 27 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) ☐ All b) ☐ Some \* c) ☐ None of:  
 1. ☐ Certified copies of the priority documents have been received.  
 2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)  
 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_.  
 4) ☐ Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.  
 5) ☐ Notice of Informal Patent Application (PTO-152)  
 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments filed November 10, 2005 have been fully considered. The rejection under 35 U.S.C 101 has been withdrawn. The arguments in regards to Peterfeso et al. (US 6,298,2752) are deemed persuasive. However the arguments in regards to Mulier et al. (US 5,431,649) are not persuasive. Therefore the rejections under Mulier et al. still stand.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claim 26 stands rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The examiner is unsure how the Applicant quantifies the smoothness of the surface of the electrode. The examiner is unsure how the microscopic surface could be greater than the macroscopic surface.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

1. Claims 1-5, 7-8, 11-13, 15-16, 23-26 and 30 stand rejected under 35 U.S.C. 102(b) as being anticipated by Mulier et al. (US 5,431,649) for reasons previously made of record.

The Applicant argues that Mulier et al. does not disclose a pacing electrode. However, the functional language and introductory statement of intended use of claim 1 has been carefully considered but are not considered to impart any further structural limitations over the prior art. Since Mulier et al. utilizes helical electrode at the distal end of the lead as claimed by the Applicant, Mulier et al. is therefore capable of being used as pacing electrode. In addition nothing prevents Mulier et al. from being used as a pacing electrode. Therefore, the helical electrode is capable of being used as a pacing electrode.

Furthermore, the Applicant argues that Mulier et al. does not disclose a closed cavity filled with an ionically conductive medium. Conversely, Mulier et al. does teach a closed cavity, as previously indicated on page 3 of the Office Action dated 8/11/05 "The examiner considers the cavity to be the lumen of the insulate housing 12". Likewise, the housing is closed cavity and port as seen in figures 1 and 2.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 10, 14, 17-20, 22, 28-29 and 31-34 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Mulier et al. (US 5,431,649) for reasons previously made of record.

The Applicant argues that Mulier et al. does not teach a pacing electrode or a closed cavity filled with ionically conductive fluid medium. However for reasons stated above and in the prior Office Action dated 8/11/05, the examiner considers this argument moot.

2. Claims 9, 17-18, 20, 22, 27, 31-32 and 34 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Mulier et al. (US 5,431,649) in view of Gates (US 5,408,744) for reasons previously made of record.

The Applicant argues that Mulier et al. does not teach a pacing electrode or a closed cavity filled with ionically conductive fluid medium. However for reasons stated above and in the prior Office Action dated 8/11/05, the examiner considers this argument moot.

3. Claims 21 and 35 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Mulier et al. (US 5,431,649) in view of Altman et al. (US 6,086,582) for reasons previously made of record.

The Applicant argues that Mulier et al. does not teach a pacing electrode or a closed cavity filled with ionically conductive fluid medium. However for reasons stated above and in the prior Office Action dated 8/11/05, the examiner considers this argument moot.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

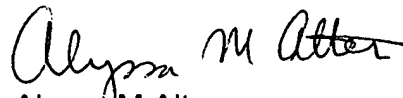
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alyssa M. Alter whose telephone number is (571) 272-4939. The examiner can normally be reached on M-F 9am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached on (571) 272-4955. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
GEORGE R. EVANISKO  
PRIMARY EXAMINER

1/19/6

  
Alyssa M Alter  
Examiner  
Art Unit 3762  
